

REMARKS

Claims 34 - 39, 41, 45 - 46, 48 - 52, 54, 56 - 65, and 67 - 73 are in this application and are presented for reconsideration. By this Amendment, Applicant has canceled claims 1 - 33, 40, 42 - 44, 47, 53, 55, and 66 and made various minor changes to the claims to improve the clarity and the style of this application. Applicant thanks the Examiner for the careful reading of the application, for pointing out discrepancies, and for providing suggestions.

Claims 34 - 39, 41, 45 - 46, 48 - 52, 54, 56 - 61, 65, 67, and 69 - 70 have been amended. The claims present subject matter which defines over the prior art. The amended claims do not add any new matter to the application.

By this Amendment, the Applicant has amended several claims to overcome the Examiner's rejections and respectfully makes assertions for overcoming the rejections of the outstanding Office Action dated December 22, 2003 in the following paragraphs.

DRAWING OBJECTION UNDER 37 CFR § 1.182

The drawings in this application filed on September 29, 1999 are objected to by the draftsperson as informal. Applicant understands this objection based on the draftsperson's letter regarding drawing corrections relating to the drawings filed on September 29, 1999 along with the original application. In that letter, drawing corrections marked in red were submitted.

Applicant requests that the Examiner approve the drawings as submitted on September 29, 1999 including the drawing corrections. Once the application has been allowed, the Applicant will provide a clean drawing of Figs. 1A, 1B, and 6.

D

CLAIM OBJECTIONS:

Claims 1 - 18 have been objected to under 37 CFR § 1.75(a) for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his/her invention.

Applicant has canceled claims 1 - 18. This is in furtherance of the Applicant's Preliminary Amendment dated September 29, 1999 which canceled claims 1 - 33 without prejudice.

Claims 34, 39, 42, 46, 60, and 69 have been objected to due to a portion of the claims which read "thereby causes said scanner". The Examiner has particularly pointed out and suggested replacing the above words with "thereby causes said paper."

Applicant thanks the Examiner for the careful reading of the application. In response to the objection, Applicant has amended claims 34, 39, 46, 60, and 69. In addition, Applicant has canceled claim 42.

Claims 35, 40, 43, 47, 58, and 67 have been objected to because the following phrase "said surface of said scanner" has been quoted twice.

In response to the objection, Applicant has amended claims 35, 58 and 67 to clarify the present invention as claimed. In addition, Applicant has canceled claims 40, 43, and 47.

CLAIM REJECTIONS - 35 USC § 102:

Claims 34 - 36, 38 - 58, 60 - 67, and 69 - 73 have been rejected under 35 USC § 102(e) as being anticipated by Ara et al. (U.S. Patent 5,889,597, "Ara '597" hereinafter).

D

The prior art as a whole including Ara '597 neither teaches nor suggests the present invention as claimed. Ara discloses a system in which a scanner and a recording apparatus are combined. Considering the teachings of Ara '597, the printer 1 and scanner 8 are used in a manner in which these are combined into one unit as shown in the Fig. 2 of the Ara '597 reference.

Ara '597 reference teaches the handling of the original documents in a following manner: the original document 6, ejected from the paper ejection port 7 of the printer 1 is transported into the scanner 8 from a paper ejection port of the scanner 8. With this an image on that original document is read by a line sensor (not shown), after which the original document 6 is transported to a paper ejection port 17 of the scanner and ejected (column 4, lines 55 - 62).

Thus, it is clear that the Ara '597 reference teaches a system whereby the gears from the scanner are engaged with the gears from the printer (column 6, lines 13 - 14). This is further supported in the Ara '597 reference which describes an auxiliary roller which presses the original document 6 or the recording paper 22 against the paper transport roller 102, thereby generating the above mentioned transportation force (column 5, lines 4 - 7).

A further review of the Ara '597 reference reveals that the prior art reference only teaches a scanner and a printer combination wherein the original document is lead through the paper path from the printer over to the paper path of the scanner or vice versa through a set of interlocking gears of the printer and the scanner. Specifically, column 9, lines 4 - 11 reads as follows:

D

" In each of the above described embodiments, the scanner unit is mounted on a downstream side in the original document and recording paper transportation system. However, in contrast to this, the scanner unit may be mounted on an off stream side of the transportation system. That is, the original document or the like is first transported inside the scanner unit, after which the original document is transported inside the printer."

Another important feature of the prior art reference, Ara '597, is that due to the interlocking gears, the scanner does not have its own motor for driving its roller. Specifically, all the motor power of the scanner 8 is be obtained from the printer 1 (column 4, lines 40 - 41). As a result, the paper transport roller 110 obtains a driving force from the printer 1 side and is able to retract the original document 6 or the recording paper 22 sent from the printer 1 on to the scanner 8 side (column 5, lines 18 - 22).

The present invention as claimed discloses a scanner and a printer combination wherein the scanner enclose a reading element, a motor, and a roller. The scanner includes a set of rollers which are driven by the motor enclosed within the scanner. Thus, when the scanner is detached from the printer, the scanner is able to run its rollers by the enclosed motor. Ara '597 neither discloses nor suggests such an independently driven scanner.

In addition, according to Ara '597 reference, the original document transporting path and the recording paper transporting path are shared. Thus, there is only one sheet transporting

D

path. However, in the present invention as claimed, a document transportation path and sheet transportation path are comprised independently. In essence, there are two sheet transporting paths: one path for the printing and another path for scanning.

The two separate paths as described above according to the present invention, is better understood with the attached drawing. Applicant hereby incorporates the attached drawing (Attachment A) for further illustration of the present invention during the prosecution of this application. According to the drawing, an arrow pointing downward on the top portion of the apparatus shows a scanner path. Parallel to the scanner path, an arrow pointing downward on the lower section of the apparatus shows the printer path.

Applicant further notes that the Ara '597 reference does not provide any suggestion or motivation which would lead a person of ordinary skill in the art to somehow include an additional motor for the scanner or to separate the gears so that an additional set of path is created for the scanner portion. Instead, Ara '597 leads a person of ordinary skill in the arts to a completely different path wherein a user of the apparatus as disclosed in the prior art reference, Ara '597, would need to combine the scanner and the printer in to one apparatus for the scanner portion to function. That is a completely different method of operation from the novel idea of having a scanner which can be operated with the printer or independently from the printer as taught by the present invention as claimed.

CLAIM REJECTIONS - 35 USC § 103(A):

Claims 37, 59, and 68 have been rejected under 35 USC § 103(a) as being unpatentable

D

over Ara '597 in view of Yamada et al. (U.S. Patent 5,559,609, "Yamada '609", hereinafter). Yamada '609 teaches a facsimile and a printer combination device with a paper feeder for feeding the recorder paper sheets in sequence to the recorded image outlet through the printer along a feeding path extending from the paper cassette disposed on the bottom of the housing body to the recording image outlet through a front side of the housing body.

Yamada '609 discloses a device where the original document is transported through the document transportation pass A and the transportation direction of the original document is changed from the downward direction to an upward direction. In addition, a recording sheet is transported on the transporting path and the recording sheet is transported from horizontal direction to vertical direction.

The present invention as claimed provides a completely separate paper path for each of the original documents as pointed out in the above paragraphs and also in the attached drawing. Thus, the combination of features not taught by the prior art provides for several improved effects for the present invention as claimed. For instance, the present invention as claimed has the advantage of providing a separate inlet for the printer and a separate inlet for the scanner. Furthermore, the scanner as taught by the present invention, can be separated from the printer and used as a separate scanning mechanism since it includes a separate motor for actuating its rollers.

Applicant finds no incentive in Yamada '609 which would lead a person to all the structural features of the separate path and a separate motor for the scanner. Thus, claims 37, 59, and 68 cannot be obvious in view of Yamada '609.

D

Furthermore, the above two advantages each are due to the combination of features as claimed. The advantages cannot be obtained from the prior art. The invention solves the problem of using the scanner to scan a document while the printer is in use. The prior art combination of Ara '597 and Yamada '609 do not recognize the problem and directs the skilled artist in a different direction.

The Yamada '609 reference also clearly fails to teach and fails to suggest the two transporting paths transporting the original document and a recording sheet downward on their transporting paths respectively. Absent a teaching or suggestion of the important feature of the invention, the combined references clearly do not direct the person of ordinary skill in the art toward the combination as claimed.

The present invention as claimed provides a different approach as compared to Yamada '609 and solves problems which Applicant has observed as noted above with regards to a connection of the path. In essence, the present invention as claimed has the first transporting path to transport a document sheet and the second transporting path to transport a recording sheet which are almost parallel and substantially vertical. As Yamada '609 fails to teach and fails to suggest the feature as taught by the present invention, Yamada '609 provides no teaching and no suggestion to the person of ordinary skill in the art to provide the combination as claimed.

There must be some suggestion or teaching in the prior art as a whole which would lead the person of ordinary skill in the art to provide the combination as claimed. As the prior art as a whole fails to direct the person of ordinary skill in the art toward the claimed combination,

D

the invention should be considered not anticipated, non-obvious and thus patentable.

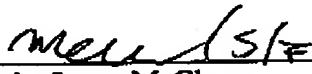
Therefore, Applicant finds that the Yamada '609 reference does not anticipate the current invention and there is no suggestion or motivation to use the teachings of the combined references to provide the combination as claimed. Thus, Applicant respectfully requests favorable consideration of the claims as presented in view of the new claims and in view of the discussion above.

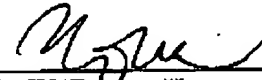
In addition, Applicant hereby reserves the right to swear behind any of the references mentioned by the Examiner under 102(e).

If the Examiner has any comments or suggestions which would further favorable prosecution of this application, the Examiner is invited to contact Applicant's representative by telephone to discuss possible changes.

At this time, Applicant respectfully requests reconsideration of this application in view of the above amendments and remarks, and Applicant respectfully solicits allowance of this application.

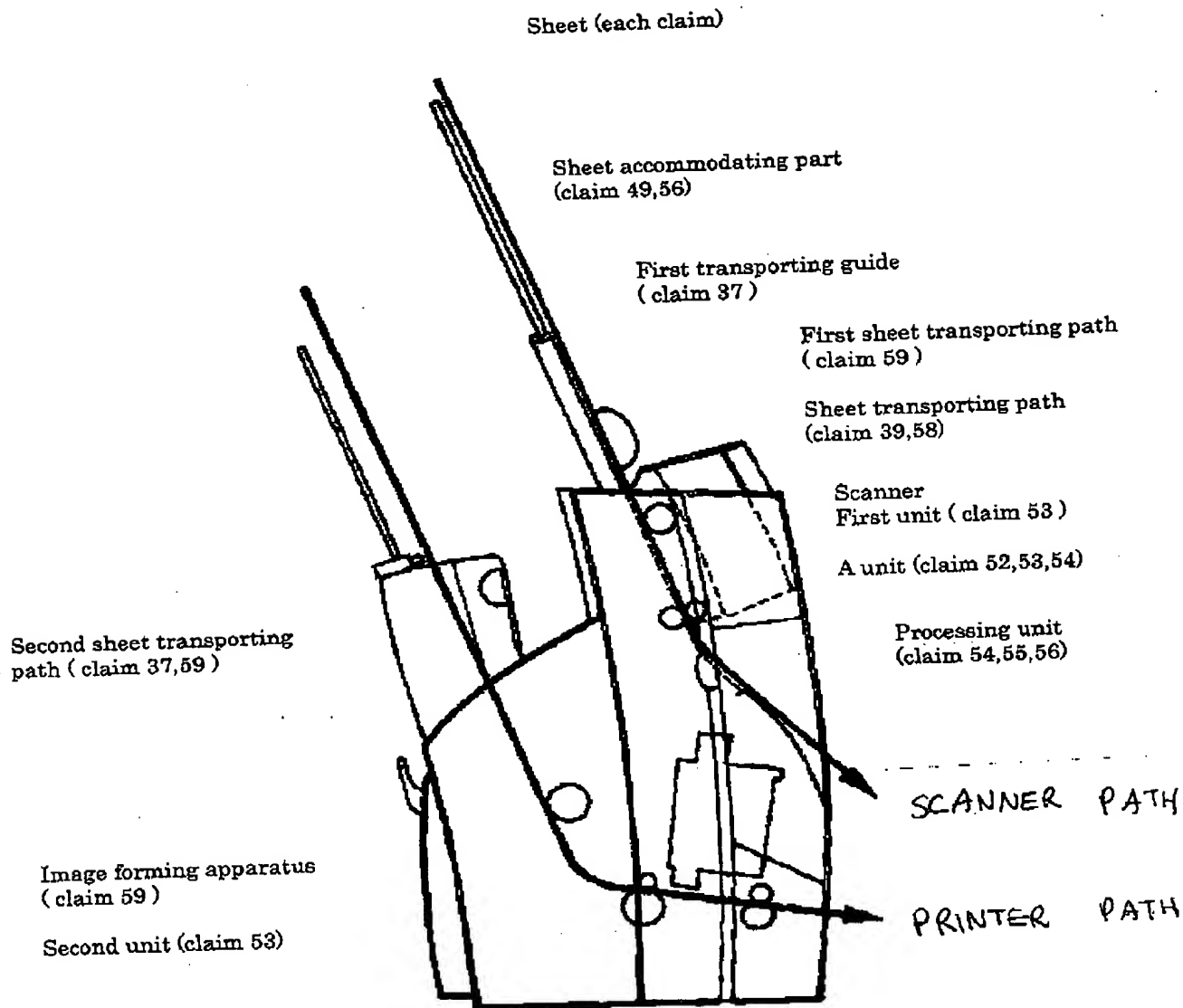
Respectfully submitted
for Applicant,

By: 
John James McGlew
Registration No. 31,903
MCGLEW AND TUTTLE, P.C.

- and -
By: 
D. W. Darren Kang
Registration No. 51,859
MCGLEW AND TUTTLE, P.C.

D

FIGURE FOR
EXPLAINING
THE
AMENDMENT.



Attachment A